

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re Patent Application of

Atty Dkt. SCS-540-513

O'BRIEN et al

C# M#

Serial No. 10/501,867

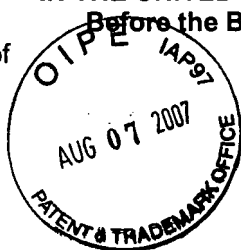
TC/A.U.: 2875

Filed: July 20, 2004

Examiner: R. May

Title: LIGHT COVER

Date: August 7, 2007



Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

☐ **Correspondence Address Indication Form Attached.**

☐ **NOTICE OF APPEAL**

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences

from the last decision of the Examiner twice/finally rejecting applicant's claim(s). \$500.00 (1401)/\$250.00 (2401) \$

☐ An appeal **BRIEF** is attached in the pending appeal of the above-identified application \$500.00 (1402)/\$250.00 (2402) \$

☐ Credit for fees paid in prior appeal without decision on merits -\$ ()

☒ A reply brief is attached. (no fee)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s)
 One Month Extension \$120.00 (1251)/\$60.00 (2251)
 Two Month Extensions \$450.00 (1252)/\$225.00 (2252)
 Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)
 Four Month Extensions \$1590.00 (1254)/\$795.00 (2254) \$

☐ "Small entity" statement attached.

Less month extension previously paid on -()

TOTAL FEE ENCLOSED \$ 0.00

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension. The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE, P.C.
 By Atty: Stanley C. Spooner, Reg. No. 27,393

Signature: _____



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REPLY BRIEF

This Reply Brief is responsive to the Examiner's Answer mailed June 7, 2007 in the above-identified application. The Examiner's response, or lack thereof, to the Appeal Brief filed December 27, 2006 raises a number of issues which are responded to below.

On page 6, under section 10 "Response to Argument" portion of the Examiner's Answer, sections A-C, the Examiner recites various assertions made by Appellants in the Appeal Brief. However, the Examiner provides no rebuttal to these general assertions and therefore they are taken as admitted. The Examiner does provide narrow concessions, but the concessions do not rebut the broader assertions.

For example, the Examiner states on page 6 that "the appellant asserts that the Gray patent has nothing to do with aircraft" Additionally, the Examiner references

Appellants' statement that "because Carlson teaches a different solution to reduce IR radiation" Because the Examiner provides no rebuttal to either of these assertions, they are taken as admitted.

Moreover, the Examiner provides a narrow concession, i.e., "the Examiner concedes that Gray does not disclose a suggestion or solution to problems specifically for aircraft external light covers or that Gray is used as a light cover for an aircraft for that matter," This narrow admission is also very much appreciated.

However, the Examiner then goes on to suggest that one of ordinary skill in the art would be motivated to use an infrared diversion mechanism for a light on an aircraft "because many weapon systems take advantage of the infrared characteristics of airplanes." Appellants' specification is not directed to any problems associated with weapon systems (aircraft or not), and instead is directed to solving the problem of cracking and breaking of light covers caused by the heat generated from a light bulb on aircraft.

The Examiner, while alleging that one would be motivated to look to the Gray reference, does not identify any evidence that Gray addresses the heating problem of aircraft light covers that is solved by the claimed invention. The Examiner's conclusory statement that one of ordinary skill in the art "would have been motivated to look to Gray to use the solution disclosed by Gray" to solve aircraft light cover problems has no evidentiary support in the record.

The Examiner fails to identify any evidence as to why one of ordinary skill in the art of aircraft light covers would look to the hyperbaric chamber art to solve a problem

related to aircraft light covers, nor has the Examiner identified any reason or motivation as to why one would look to the Gray reference.

With respect to claims 4 and 5, the Examiner provides no rebuttal to the Appellants' assertion and therefore this is taken as admitted. The Examiner does provide a narrower concession, in that "Bamber does not disclose use with aircrafts [sic] in particular . . ." and this admission is appreciated. Then, the Examiner merely reasserts that Bamber is used to show that a polycarbonate material could be used for a cover because it is cheap to manufacture and light in weight. While there are hundreds of other materials which are "cheap to manufacture and lightweight," there is no "reason" or "motivation" identified for one of ordinary skill to choose a polycarbonate material over any one of the other materials for this particular application. Therefore, the Examiner's failure to rebut Appellants' factual assertions is clear evidence that he has failed to support his combination rejection.

With respect to the Gagnon reference, the Examiner does not rebut the assertion that the reference has nothing to do with aircraft exterior light covers. Additionally, the Examiner's concession that "Gagnon fails to explicitly disclose a use for an aircraft cover or light cover" is appreciated. The fact that Gagnon teaches a scratchproof coating does not appear to contain any motivation or reason for combining Gagnon with the Gray reference.

The Examiner further contends that the Appellant is attempting to show "nonobviousness by attacking the references individually." This is incorrect. Appellants are attacking the Examiner's hindsight reasoning in picking and choosing elements from

amongst a plurality of references and then combining them only in the manner suggested by Appellants' claims.

As this is well settled as an improper manner of setting forth an obviousness claim, the rejection is improper. The Examiner's attention is directed to a May 3, 2007 Memorandum from the Deputy Commissioner for Patent Operations, Margaret A. Focarino, confirming that the Supreme Court in the recent *KSR* decision affirmed the Graham factors. In conclusion, the Deputy Commissioner held that "in formulating a rejection under 35 USC §103(a) based upon a combination of prior art elements, it remains necessary [for the examiner] to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." This interpretation is well supported in the *KSR* decision and is a reflection of the consistently applied requirement of there being some "reason" or "motivation" to pick and choose elements from various references and then combine them in the manner of applicant's claims. The Examiner has simply failed to identify the required "reason" or "motivation."

In his analysis, the Examiner fails to mention the fact that the Carlson reference (still applied in his combination rejection) teaches that, rather than reflecting the infrared component of light generated by an aircraft landing light, Carlson teaches the desirability of providing a liquid cooling system to remove heat by conduction from the light cover. The Examiner fails to answer the question as to why one of ordinary skill in the art would take only the aircraft light cover aspect from the Carlson reference and combine it with only the IR mirror of Gray to provide Appellants' claimed solution to the problem. Such

combination requires the Examiner to ignore the Gray use of the IR mirror in combination with a hyperbaric chamber and to ignore the whole point of the Carlson patent, i.e., water cooling of aircraft light covers. The Examiner has simply failed to explain why it would be obvious to one of ordinary skill in the art to pick and choose specific teachings from the Gary and Carlson references and then combine them in the manner of Appellants' claims.

The Examiner has also failed to provide any evidence or response to Appellants' conclusion in heading C that the Carlson reference would actually lead one of ordinary skill in the art away from the claimed combination of elements. He has not rebutted the Court of Appeals for the Federal Circuit decision in *In re Fine* which specifically indicates that it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." *In re Fine*, USPQ2d 1596, 1599 (Fed. Cir. 1988).

As a result, the Examiner has simply not met his burden of establishing a *prima facie* basis of obviousness for the combination of the Gary and Carlson references by themselves or in combination with Bamber and additionally with Gagnon and the rejection is respectfully traversed.

Regarding the anticipation rejection under 35 USC §102 of Appellants' claim 9 over the Gray reference, the Examiner on page 9 of the Examiner's Answer alleges that Appellant is relying upon claimed features which are "not recited in the rejected claim." The Examiner is simply incorrect in his assertion.

The term "light cover" is used synonymous with "transparent covers over exterior light sources on moving vehicles or aircraft" as recited in Appellants' specification, lines

6-7 (see also the definition of “light cover” set out in the specification at page 3, lines 10-12, i.e., “**a transparent element** 2 that is substantially the size and shape of the required light cover” (emphasis added)). The Examiner has not disputed the specification definition of the term “light cover” and has provided no evidence which indicates that the use of the term “light cover” in Appellants’ claims would mean anything different than that set out in the specification. Therefore the definition of the claim phrase “light cover” is a transparent cover “over exterior light sources on moving vehicles or aircraft.”

Finally, in the context of Appellants’ claim, to have a light cover which is not “transparent to visible light” as suggested by the Examiner is simply foolishness and defeats the whole point of the invention. As long as Appellants have defined “light cover” as “a transparent element” in Appellants’ specification and then used the term “light cover” in the claims in a consistent fashion, the Examiner is obligated to apply the specification definition to the claim language. The Examiner’s failure to do so is simply reversible error.

Additionally, the Examiner traverses Appellants’ statement that Gray does not teach a “light cover that is placed over the light source.” Appellants have previously pointed out that at column 2, lines 51-52, the Gray reference specifies the so-called “protective cover 10” (which the Examiner contends is the claimed “light cover”) is comprised of “sheet metal or insulated material.” There is no evidence of record suggesting that sheet metal or insulated material is transparent and such materials in the Gray reference are completely inconsistent with the definition of “light cover” in Appellants’ claims and Appellants’ specification. The Examiner does not indicate how

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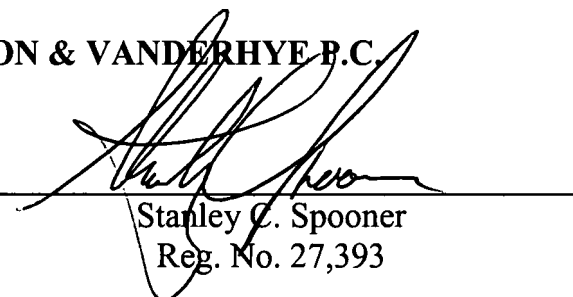
or why he believes a non-transparent “protective cover 10” in Gray contains any suggestion of Appellants’ “transparent element 2” in the definition of Appellants’ “light cover.” The Examiner is simply avoiding the claim language by denying that it is in the claim and thereby committing clear reversible error.

Thus, and in view of the above, the rejection of claims 1-7 and 9 under 35 USC §§102 and 103 is clearly in error and reversal thereof by this Honorable Board is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

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